

### **REMARKS**

Entry of this Amendment, reconsideration of all grounds of rejection, and allowance of this Application are respectfully requested in light of the foregoing amendments to the claims and the following remarks. Claims 1-14 and 16-65 remain pending herein.

In response to the Examiner's objection, Applicant has renumbered Claims 61-66 as 60-65, respectively. Current claim 65 (formerly claim 66) has been amended to depend from current claim 64.

#### **Summary of the Rejection**

**I. Claims 1-14, 16-58, 59 and 61-66 stand rejected under 35 U.S. §103(a) in view of Eintracht et al. (U.S. 6,687,878, herein after "Eintracht") in view of Rivette et al. (U.S. 6,877,137 herein after "Rivette").**

#### **Applicant's Traversal**

Claims 1-14, 15-58, 59, and renumbered claims 60-65 stand rejected under 35 U.S.C. §103(a) over the combination of Eintracht in view of Rivette. Applicant respectfully traverses this ground of rejection for the reasons to be discussed herein below.

**Rationale in the Office Action for rejecting independent claims 1 and 23, (see paragraph number 5 on pages 3-4 of Office Action)**

It is alleged in the Office Action that with regard to claims 1 and 23, that Eintracht allegedly discloses all of the recited elements of claims 1 and 23 except for the recitation that:

*at least one collaborative content element that comprises at least one annotation therein and rendering instructions therefore so as to annotate said base document by embedding said at least one annotation and instructions therefore as an encoded representation of collaborative content and forwarding the collaborative content to a server for execution;*

However, it is also alleged in the Office Action that Rivette discloses the annotation and rendering instructions being embedded as recited above, and thus independent claims 1 and 23 would have been obvious to an artisan at the time of invention over the combination of Eintracht and Rivette.

Applicant's traversal of the above ground of rejection

Applicants respectfully submit that claims 1 and 23 (and claims directly or indirectly dependent thereon) would not have been obvious to an artisan at the time the invention was made in view of the combination of Eintracht and Rivette.

First of all, in the presently claimed invention, one of the disclosed advantages is that the changes to a document are not kept in a separate database, which would require additional capability at the client side to access the separate data base containing the notes. The inventors have *embedded both the collaborative content and the rendering instructions to display in a URL (typically) of the base document*. This functionality is one of several reasons that the efficiency of the presently claimed system is superior to, and patentably distinguishable from, the teachings of the combination of Eintracht and Rivette.

For example, in the presently claimed invention, there is virtually no retrieval time to display collaborative content because the collaborative content does not have to be fetched from a database in a separate transaction, or retrieved by clicking on a link to go to another webpage (or website) or by accessing a separate notes database.

In contrast, while the Office Action admits the Eintracht does not explicitly disclose the above claim language (marked in italics), Applicant respectfully submits that neither Eintracht, Rivette, nor their combined teachings discloses or suggests embedding the collaborative content and the rendering instructions in the original base document.

In support of the above, Applicant respectfully submits that the combination of Eintracht and Rivette fails to disclose or suggest the recitations found in independent claims 1 and 23 because when examining the combined teachings of the references, it is clear that Eintracht discloses a system for collaborative document annotation whereby notes (i.e. annotations) associated with a document are stored in a notes database on a central notes server.

For example, Eintracht discloses that the notes are separate from the document. For example, Fig. 7 of Eintracht shows that document is first requested (step 140), and after the loading of a plug-in and image display (step 142), the document notes are requested (step 144), wherein a note buffer is first prepared and then the notes are sent

(step 146) and displayed by user (see also Eintracht at column 14, line 48 to column 15, line 23).

Thus, a skilled artisan would understand that Eintracht discloses that the notes are clearly separate from the underlying text, and the user requires a notes buffer, which is transmitted to the client. The client then updates a local notes database (Eintracht, column 14, line 63 to column 15, line 5). Accordingly, the system disclosed by Eintracht requires a powerful device with sufficient memory to store separately a local notes database. The client then receives all the notes for a particular document and updates the database with the information received.

Moreover, Eintracht discloses at column 15, lines 54-58 that "[T]he structure of the local note client database is similar to that of the server note database with the exception that no authentication checks are performed on the client. Thus, for example, the note database on the client does not contain a Note Owner password field." In other words, Eintracht is disclosing that the client executes the changes to the document, including updating of a local notes database (see Fig. 9 of Eintracht).

With regard to Rivette, Applicant respectfully refers the Examiner to Fig. 5 of this reference, where there is shown a separate "Notes Database 508", that is accessed by clicking on links in the base document. Also, please see the drawing on the cover of the patent (Fig. 28) which shows a series of notes database and object linking databases that are distributed among two sets of sites (see column 28, lines 48-64) connected by fiber optics, coaxial cable, wireless, satellite, etc. Thus, in Rivette the collaborative content is distributed among a plurality of databases, not embedded with rendering instructions in the base document. Rivette discloses the embedding of a number of hyperlinks to go to, for example, one or more of the plurality of databases shown in Fig. 28.

Moreover, Rivette (similar to Eintracht) *fails to disclose that the collaborative content and the rendering instructions are embedded in the base document*, and therefore the combination of Eintracht and Rivette fails to disclose or suggest at least this element recited by independent claims 1 and 23 of the present invention.

Additionally, Applicants respectfully submit that Rivette, at best, discloses embedding a linking button (please see figure 35, step 3512, wherein a notes engine commands an application associated with the Web page to display a linking button to

locate a new sub-note). The aforementioned linking button is different from and does not obviate embedding actual collaborative content (as opposed to a link to collaborative content) and rendering instructions for viewing the embedded collaborative content.

In the Office Action, a passage in Rivette at column 7, lines 45-47 is alleged to disclose a computer program that "attaches annotations" to data objects, but it is understood by an artisan that this disclosure is in the context of, for example, attaching notes to data objects, as can be done in MS Word or WordPerfect or Excel (please see Rivette, column 3, lines 38-59), which is patentably distinguishable from the claimed invention.

For example, it is first noted that there is no client-server relationship using MS Word et al. in the context of Rivette (he is talking about Word being accessed on a personal computer), and thus in Rivette there is no generating by an originator client workstation of a collaborative content element that comprises at least one annotation and rendering instructions.

Second, while it is alleged in the Office Action that Rivette discloses rendering instructions at column 8, lines 13 to 30 and column 18, lines 12 to 24, these pages are instead referring to a discussion of providing links to information at another file possibly in another database, as opposed to embedded rendering instructions.

Moreover, it is respectfully submitted that there is no suggestion or motivation found in the references to support why an artisan would have attempted to combined them.

As disclosed in the MPEP §2143, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the reference or in the knowledge in the art, to modify the reference. Second there must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all the claim limitations. As held in *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), the long-standing principle was affirmed that the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not in Applicant's disclosure. In this respect, a proper *prima facie* case of obviousness has not been set forth in the Final Office Action.

Therefore, for at least the above reasons, it is respectfully submitted that a person of ordinary skill in the art would not have found any of instant claims 1 - 14 and 16-65 to have been obvious over a combination of teachings of Eintracht and Rivette because there is no motivation to combine the references. In addition, assuming *arguendo*, even if a person of ordinary skill in the art were to have combined the teachings of Eintracht and Rivette, there would not have been any suggestion or motivation set forth in the combination of teachings that would have disclosed or suggested the embedding of collaborative content and rendering instructions created at a client in an original base document at the server as claimed.

Accordingly, to restate, there is no suggestion that could have been gleaned by a person of ordinary skill in the art in view of the combination of Eintracht and Rivette to embed the aforementioned collaborative content so that, for example, client workstations do not need any dedicated software installed other than an Internet browser and a scripting language permitting devices such as PDA's to be able to view and annotate the documents without adding proprietary software (specification, page 7, paragraph 29, last 8 lines), which is another advantage of the presently claimed invention.

In addition, the combination of Eintracht and Rivette fail to disclose or suggest to a person of ordinary skill in the art the following:

*Eintracht fails to disclose or suggest the generating step as recited in Claim 1*

Eintracht discloses a system for collaborative document annotation whereby notes (i.e. annotations) associated with a document are stored in a notes database on a central notes server. In Eintracht, it is disclosed that the notes are separate from the document. For example, Fig. 7 of Eintracht shows that document is first requested (step 140), and after the loading of a plug-in and image display (step 142) the document notes are requested (step 144), wherein a note buffer is first prepared and then the notes are sent (step 146) and displayed by user (see also Eintracht at column 14, line 48 to column 15, line 23).

In contrast to the combination of Eintracht and Rivette, an artisan appreciates that the presently claimed invention does not require operation of a local notes database at the client side. One advantage of the claimed invention over the system disclosed by Eintracht is that Eintracht's system could not be operative in many small client

workstations such as cell phones, PDAs, Internet appliances, pagers, and pocket pc's, the presently invention discloses at paragraph [0066] that the invention is suitable for cell phones, PDAs, Internet appliances, pagers, and pocket pc's, and specifically claims this feature (see, for example, present claim 31). Typically, if the document is HTML-based or Java scripted, in the present invention the client can annotate the drawings with only a browser and a graphical collaboration tool, and does not require a notes database that must be updated when a new document is viewed.

Moreover, in contrast with the combination of Eintracht and Rivette, independent claims 1 and 23 of the present invention, for example, recite comprising at least one annotation therein and rendering instructions therefore. In addition, Claim 1 recites that there is a document identifier that identifies a location of a content of said base document, and the collaborative content is embedded (into the document identifier) as an encoded representation of collaborative content.

In contrast, both Eintracht and Rivette disclose that the notes are separate from the underlying document, and fail to disclose or suggest embedding annotations and rendering instructions in a document identifier, as in the present claims.

Accordingly, reconsideration and withdrawal of all grounds of rejection against claims 1 - 23 are respectfully requested.

With regard to claims 2 and 24, these claims are allowable at least for being dependent on an allowable independent claim (claim 1 or 23 respectively) and because of an independent basis for patentability. For example, while claims 2 and 24 disclose adding another collaborative content element, Applicants respectfully submit that neither Eintracht or Rivette generate transmit and render collaborative content as presently claimed, and thus the combination of Eintracht and Rivette fails to disclose or suggest adding another collaborative content element as presently claimed.

With regard to claims 3 and 25, the annotating options allegedly disclosed by Eintracht do not include embedding, which is recited in the present claims. Thus, the combination of the combination of Eintracht and Rivette fails to disclose or suggest annotation options as presently claimed.

With regard to claims 4 and 26, as an embedded collaborative element as is presently claimed can be distinguished over the collaborative element disclosed by

Eintracht, where the collaborative element of Eintracht is stored in a separate notes database. The inputting of a text element to name the collaborative element does not change the structural difference of the two elements.

With regard to claims 5-14, 27-40, and 59-65 these claims are also patentable at least because of their dependence from one of claims 1 and 23, which are believed to be patentable for reasons previously indicated and because of an independent basis as well.

Traversal of Independent Claims 17, 41 and 53

In addition, claims 17, 41 and 53 recite, respectively, a network collaboration tool, a client system for network collaboration, and a server system for network collaboration, all of which are directed to a system to a system containing both collaborative content including a base document with at least one annotation and rendering instructions embedded therein, and such system is not disclosed or suggested by the combination of Eintracht and Rivette.

With regard to base claims 17, 41 and 53, the combination of Eintracht and Rivette also fails to disclose or suggest the rendering of base document with annotations and instructions embedded therein.

For example, the combination of Eintracht and Rivette fails as a combination to disclose or suggest any of the present claims. For example, Eintracht discloses that the location of an annotation is called a Note Anchor and is kept separate from the annotated data (column 7, lines 60-63). Once a note is created, its anchor point can be changed by the user.

Furthermore, while the presently claimed invention recites an embedding of the annotation and rendering instructions in the document identifier, Eintracht does not embed the annotation and rendering instructions in a document identifier as presently claimed. In fact, Eintracht merely discloses identifying the notes by, for example, by number (please see Fig. 12 of Eintracht, notes 250, 252), and it should be noted that Fig. 10 shows the client annotation event data structure as well, which is a response buffer in which the notes are stored (column 16, lines 51-52).

Finally, it should be noted that Eintracht discloses in the Abstract that "the documents and associated annotations are treated independently from each other whereby separate data structures are created for the documents and for the associated annotations."

Thus, it cannot be said that Eintracht in combination with Rivette discloses the recitation of present claim 17, or that of base claims 17, 41 and 53 (and all claims dependent thereon), with regard to embedding. For example, in Claim 17, the collaborative element generated by the graphical collaboration tool is not disclosed.

With regard to claim 53, Eintracht and Rivette fail at least to disclose a system wherein a processor executes a document having annotations and instructions embedded in the document identifier. With regard to claim 41, Eintracht and Rivette fail at least to disclose a graphical collaboration tool downloaded from a server for generating collaborative content and rendering instructions, wherein the collaborative content having an annotation and rendering instructions for execution is embedded in the document identifier. With regard to claim 53, Eintracht and Rivette also fail at least to disclose a server process as claimed. Finally, claims 54-65 are also allowable in view of the combination of references.

Accordingly, Applicants respectfully submit that none of the present claims (1-14 and 16-65) would have been obvious to a person of ordinary skill in the art at the time of invention in view of Eintracht and Rivette.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) are respectfully requested.




**CONCLUSION**

In view of the foregoing remarks and analysis, it is respectfully submitted that all rejections stated in the Office Action have been overcome. A Notice of Allowance is respectfully requested.

In the event that the Examiner believes that it may facilitate the advancement of this application, the Examiner is invited to contact the undersigned attorney at the local Washington, D.C. telephone number indicated below.

Respectfully submitted,



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